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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,325	06/27/2003	Vincent S. Darago	5045.2.1D	7892

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OGILVIE LAW FIRM
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EXAMINER

HOANG, HIEU T

ART UNIT	PAPER NUMBER
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2152

MAIL DATE	DELIVERY MODE
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06/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/609,325	Applicant(s) DARAGO ET AL.	
	Examiner Hieu T. Hoang	Art Unit 2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 86-106 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 86-106 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 05/14/2007.
2. Claims 86-106 are pending and presented for examination.

Response to Amendment

3. The terminal disclaimer filed on 05/14/2007 has been acknowledged.

Response to Arguments

1. Applicant's arguments filed 05/14/2007 have been fully considered but they are not persuasive.
2. Argument 1 is presented on page 1 and first paragraph of page 2 wherein applicant argues that In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the applicant argues "Wiser seeks widespread delivery of music to consumers, whereas Schell provides restricted communications to protect confidential information in business such as banking..." In fact, the prior art Wiser-Schell provides music distribution with

authorization and security protection (Wiser, abstract lines 18-26), and protects the loading of data (read and write) by disabling write or locking registers to prevent the content being modified (Schell, col. 2 lines 43-44 and 56-59).

3. Argument 2 is on par. 2 and 3 of page 3 wherein applicant argues that Schell's write disabling scheme is inapplicable to Wiser's invention. Schell discloses a prevention of the loading of data (read and write) by disabling write or locking registers to prevent the content from being modified (Schell, col. 2 lines 43-44 and 56-59). One skilled in the art at the time of the invention can appreciate that Schell's disclosure of disabling write of a register is totally applicable to disabling write of a disk writer (e.g., a CD writer), for instance, to prevent writing or copying of copyright protected media or licensed information. In this case, to "prevent a copy of the critical portion of the content from being created on nonvolatile storage" is just an example of many applications that Schell's disabling writes can be applied.

4. Argument is presented on page 4 of the Response wherein applicant argues that the prior art does not teach "peer-to-peer nodes" and "serving at least the critical portion over a network communications link to a peer node."

In response to applicant's arguments, first, the recitation "peer-to-peer nodes" has not been given patentable weight because the recitation occurs in the preamble of claim 87. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body

of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Second, the preamble of the claim also states that "peer-to-peer nodes which perform as content servers and/or clients," therefore it is a reasonable interpretation to read "a peer node" as recited in the claim as a node in communication with another in a network consisting of clients and servers.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 86 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser (US 6,385,596, hereafter Wiser), in view of Schell et al. (US 6,477,648, hereafter Schell).

6. For claim 86, Wiser discloses a method for managing content in a shared use operating environment (abstract), the shared use operating environment including a registration server (fig. 1B media licensing center 110), a content server connectable by

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a network link to the registration server (fig. 1B content manager 112), and a client workstation connectable by a client-server network communications link to the content server (fig. 1A, client system 126 linked to content manager 112 of fig. 1B), the method comprising the steps of:

- registering a user at the registration server, thereby characterizing the user as a registered user (col. 4 lines 13-14);
- reserving a particular piece of courseware content for a particular registered user (fig. 9AB, request reservation 916);
- receiving at the content server a request by the registered user for access to content which contains at least one previously treated critical portion (col. 9, lines 25-28 and 56-60, delivery server receives requests with a preset consumer certificate);
- authenticating the request (fig. 9BA, authenticate consumer certificate with receipt 946)
- serving at least the critical portion over the client-server network communications link for presentation to the registered user at the client workstation (col. 9 lines 60-67);
- metering usage of the content by the registered user (col. 4 lines 51-67, the voucher specifies the media being purchased);
- monitoring the client-server network communications link (fig. 6A, fig. 7A, processes on link between web browser 128 and media licensing center 110 or between web browser 128 and content manager 112 are monitored);

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- downloading at least one non-critical portion of the content to the client workstation at least two hours before serving the critical portion (col. 3 lines 55-62, low quality media can be previewed anytime which can one or two hours before a purchase the high fidelity version, which involves authorization);
- presenting the registered user with an invoice for usage of the content (col. 5 lines 4-6).

Wiser does not disclose:

- disabling caching and other disk writes to prevent a copy of the critical portion of the content from being created on nonvolatile storage at the client workstation;

However, Schell discloses:

- disabling caching and other disk writes to prevent a copy of the critical portion of the content from being created on nonvolatile storage at the client workstation (col. 2 lines 43-44 and 56-59, disable write to prevent modifying data, or writing new data);

Therefore, it would have been obvious for one skilled in the art at the time of the invention to combine the teachings of Wiser and Schell in order to disable write to prevent license information being copied or reproduced at the client's computer.

7. Claim 87-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Salesky et al. (US 6,343,313, hereafter Salesky), in view of Wiser.

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8. For claim 87, Salesky discloses a method for managing content in an operating environment that includes peer-to-peer nodes which perform as content servers and/or clients (abstract), the method comprising the steps of:

- registering users (col. 2 lines 8-15);
- checking user passwords to prevent unregistered users from receiving content services (col. 2 lines 8-15);

Salesky does not disclose :

- receiving at a node a request by a registered user for access to content which contains at least one previously treated critical portion; and
- serving at least the critical portion over a network communications link to a peer node for presentation to the registered user.

However, Wiser discloses:

- receiving at a node a request by a registered user for access to content which contains at least one previously treated critical portion (col. 9, lines 25-28 and 56-60, delivery server receives requests with a preset consumer certificate); and
- serving at least the critical portion over a network communications link to a peer node for presentation to the registered user (col. 9 lines 60-67).

Therefore , it would have been obvious for one skilled in the art at the time of the invention to combine the teachings of Salesky and Wiser in order to send and receive licensed content as described by Wiser in a conferencing system of Salesky to provide Salesky's system with features such as copyright and intellectual property protection.

9. For claim 88, Salesky-Wiser discloses the invention substantially as described in claim 87. Salesky-Wiser further discloses the serving step serves digital content that contains at least one musical recording (Wiser, abstract).

10. For claim 89, Salesky-Wiser discloses the invention substantially as described in claim 87. Salesky-Wiser further discloses the serving step serves digital content that contains visual images (Salesky, col. 3 lines 24-26).

11. For claim 90, Salesky-Wiser discloses the invention substantially as described in claim 87. Salesky-Wiser further discloses the serving step serves video content (Salesky, col. 3 lines 30-33).

12. For claim 91, Salesky-Wiser discloses the invention substantially as described in claim 87. Salesky-Wiser further discloses the method delivers content by synchronous sharing (Salesky, col. 3 lines 42-50).

13. For claim 92, Salesky-Wiser discloses the invention substantially as described in claim 91. Salesky-Wiser further discloses the method comprises video conferencing (Salesky, col. 3 lines 42-50).

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14. For claim 93, Salesky-Wiser discloses the invention substantially as described in claim 87. Salesky-Wiser further discloses the method delivers content in a real-time manner (Salesky, col. 3 lines 42-50).

15. For claim 94, Salesky-Wiser discloses the invention substantially as described in claim 87. Salesky-Wiser further discloses the method delivers content in an interactive manner (Salesky, col. 3 lines 42-50, video conference is an interactive application).

16. For claim 95, Salesky-Wiser discloses the invention substantially as described in claim 87. Salesky-Wiser further discloses the critical portion comprises encrypted content (Wiser, col. 7 lines 27-30).

17. For claim 96, Salesky-Wiser discloses the invention substantially as described in claim 87. Salesky-Wiser further discloses the critical portion comprises compressed content (Wiser, col. 7 lines 20-25).

18. For claim 97, Salesky-Wiser discloses the invention substantially as described in claim 87. Salesky-Wiser further discloses the critical portion comprises licensed content (Wiser, col. 10 lines 18-24).

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19. For claim 98, Salesky-Wiser discloses the invention substantially as described in claim 87. Salesky-Wiser further discloses the critical portion comprises content that is compressed and encrypted (Wiser, col. 7 lines 20-30).

20. For claim 99, Salesky-Wiser discloses the invention substantially as described in claim 87. Salesky-Wiser further discloses the step of disabling use of at least a portion of the content after an expected security handshake is not received (Salesky, col. 10 lines 23-36, audio image data can only be used after being authenticated using public-private keys).

21. For claim 100, Salesky-Wiser discloses the invention substantially as described in claim 87. Salesky-Wiser further discloses the step of downloading at least a portion of the content to a peer node at least one hour before the serving step (Salesky, col. 9 line 64-col. 10 line 7, prerecorded audio conference for playback some time later).

22. For claim 101, Salesky-Wiser discloses the invention substantially as described in claim 87. Salesky-Wiser further discloses the method moves content to peer nodes in response to anticipated requests from users (Salesky, col. 9 line 64-col. 10 line 7, anticipated requests are requests for a prerecorded session).

23. For claim 102, Salesky-Wiser discloses the invention substantially as described in claim 87. Salesky-Wiser further discloses the method moves content to peer nodes in

response to actual requests from users (Salesky, col. 7 line 66-col. 8 line 10, attendee sends a command to conference server to obtain the latest image information).

24. For claim 103, Salesky-Wiser discloses the invention substantially as described in claim 87. Salesky-Wiser further discloses the method operates in conjunction with a license enforcement software program executing on a client node (Wiser, col. 10 lines 13-16).

25. For claim 104, Salesky-Wiser discloses the invention substantially as described in claim 87. Salesky-Wiser further discloses the method tracks content use in order to create records on which invoices are at least partially based (Wiser, col. 9 lines 40-52).

26. For claim 105, Salesky-Wiser discloses the invention substantially as described in claim 87. Salesky-Wiser further discloses the method tracks content location and determines whether content is already resident on a peer node at or near a location at which content is requested (Salesky, fig. 10A, client 18(a) requests for conference content from server 14(c), which queries server 14(b), then 14(a) for conference content).

27. For claim 106, Salesky-Wiser discloses the invention substantially as described in claim 87. Salesky-Wiser further discloses only authenticated network users are able to access the content (Salesky, col. 2 lines 8-15).

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hieu T. Hoang whose telephone number is 571-270-1253. The examiner can normally be reached on Monday-Thursday, 8 a.m.-5 p.m., EST.

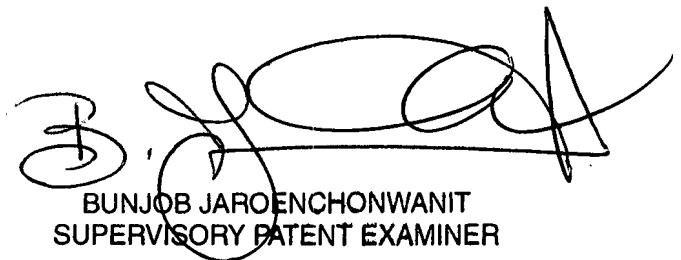
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HH

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BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER

5/29/07